



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,329	03/26/2004	Valery Levitan	WH-11 979US	8232
24962 7590 01/28/2009 DENNISON ASSOCIATES 133 RICHMOND STREET WEST SUITE 301 TORONTO, ON M5H 2L7 CANADA				
EXAMINER				
SHAH, MILAP				
ART UNIT		PAPER NUMBER		
3714				
MAIL DATE		DELIVERY MODE		
01/28/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/809,329

**Applicant(s)**

LEVITAN ET AL.

**Examiner**

Milap Shah

**Art Unit**

3714

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 10, 2008 has been entered.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 11, & 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson (U.S. Patent Application Publication No. 2002/0103019; of record).

**Claim 1:** Emmerson discloses the invention substantially as claimed including a personal portable device (i.e. mobile or cellular telephone – paragraph 0002) to be carried by a user and having a primary practical function (i.e. to make telephone calls) and a secondary personal entertainment function (i.e. to play games), the primary practical function including the capability to communicate over a wireless communication network with a separate computer (figure 2 & paragraph 0022), the secondary personal entertainment function includes a series of downloadable games downloaded to the personal portable device using the communication capability of the primary practical function to form a wireless connection with a game server computer and have the game server

computer download at least one additional game, the at least one additional game including as part thereof a tracking arrangement for tracking usage information with respect to the play of the at least one game and to communicate the use information to the game server computer over the wireless communication network when the personal portable device is in communication with the game server computer (see at least paragraphs 0022-0026, 0032-0033, & 0040-0041), the at least one game being operable to receive from the game server computer when the personal portable device is in communication with the game server collective results for said at least one game of other personal portable devices including collective high score ranking information (paragraphs 0040-0041, where Emmerson discloses that game server receives scoring information from each of a plurality of players, updates a league table with the standings of each player and informs the player where he stands in the league table, thus collective use information is obtained).

Emmerson appears to lack an explicit disclosure that the game is playable in a local mode and a registered mode where each mode includes game summary information maintained on the personal portable device including a series of high scores for collective users, the high scores in the local mode accepting any identified user and the high scores in the registered mode requiring each user to be registered with the game server, where the high scores are uploaded to the game server from the personal portable device.

Nonetheless, the Examiner submits that (1) a local mode for a game device is notoriously well known in the art; and (2) Emmerson reasonably discloses the registered mode in which registered players upload their scores to a game server; thus, it would have been an obvious matter to modify Emmerson to operate in either mode based on game play, high score achieved, or selection by the player.

As to (1) above, it is notoriously well known in the art for devices having games playable thereon, such as mobile phones, arcade games, gaming consoles, personal computers, and the like, to offer a local mode where any username desired may be entered by a player when a score eligible for the high scores list is achieved in the game. Such a 'high scores' list or leader board is a well known concept in the gaming arts and has been employed in a plethora of games on various platforms and devices and the like for decades. The Examiner will furnish a teaching reference for the well known concept of the 'local mode' as claimed upon Applicant's request. Regardless, those skilled in the art would recognize such a mode is common practice in the art.

Next, as to (2) above, Emmerson discloses a modern age of competition based on high scores in a game, whereby instead of being limited to compete against friends or family local to the game device, a player enjoys the excitement of competing globally with anyone that has the same game. Emmerson discloses a user initially registers with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026). Thus, Emmerson essentially appears to disclose a registered mode requiring each user being registered with the game server and their score being uploaded to the game server. Emmerson appears to suggest that scores be uploaded to a game server for the purpose of competition. In a similar version of Emmerson, it would have been an obvious matter to merely upload game scores and maintain a global 'list' of scores in a single-player type game, as 'the game' referenced is an obvious design consideration. For instance, a single player game such as the old and well known Tetris operable in a registered mode merely allows a player to submit their score to an online leader board or list of high scores so that others can see their registered name associated with a score. Such a

version does not appear to discourage any players as anyone may obtain a high score and add their registered name to the high scores list.

Consequently, given the teachings of Emmerson combined with a well known 'local mode' as claimed, it would have been obvious to one of ordinary skill in the art to modify Emmerson to allow play of particular games in a local mode for the purpose of allowing the player to play games locally with friends or to allow a player to practice, such then when the player plays the game in the registered mode competing against other players globally, they've had the opportunity to practice and enhance their skills. Furthermore, in a broad sense, Applicant's claimed local mode and registered mode may be correlated to well known "single player" and "multi-player" modes in a vast plethora of known games. For instance, certain known games having a single player mode allow a player to play whichever game it may be in a single player mode allowing the player to enhance their skills. These known single player modes are also known to include a high scores list for single player play or 'local play'. Similarly, the multi-player play as is known in one embodiment, allows for players to play over a network against non-local players, which normally requires a registered name, where the registered mode also includes a global high scores list of all playing in the multi-player mode. It should also be noted that 'the game' referenced above need not necessarily be any particular game referenced within Emmerson, that is, any compatible game or game type may employed on the personal portable device of Emmerson, thus, Tetris as discussed above may be played in a local or single player mode (i.e. game play with local high scores) or in a registered or multiplayer mode (i.e. same game in which resultant scores are compared globally). Therefore, the Examiner is not persuaded that newly added limitation of a specific local mode and specific registered mode each having their own collective series of high scores patentably distinguishes over the known prior art.

**Claim 3:** Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

**Claim 4:** Emmerson discloses a web browser application as being present on the mobile phone (paragraph 0024). Emmerson also discloses a subscription/registration process, whereby a player must have initially subscribed or registered to the game server to participate in multiplayer games through the game server. Thus, upon connection to the game server, the server performs an authentication process to determine if the player has previously subscribed and has access to the game server. If yes, access is granted and the game selection process continues. However, if no subscription is determined, the player is denied access and alternatively provided with instructions on how to register/subscribe and pay the necessary fees to access the game server. Further, for purposes of filling out a registration or subscription form, the browser on the mobile phone must be utilized, thus, Emmerson discloses allowing a user to initially register with the game server, or if the player has previously registered, allowing the player to participate in gaming activities such as downloading games, submitting scores, receiving collective scores, or the like (paragraphs 0025-0026).

**Claim 5:** Emmerson discloses that at block 260 (figure 4), the server downloads an updated league table with collective use information to the player's mobile phone, where such information is selectively displayable when the player wishes to view his standings in the league table (paragraph 0041).

**Claim 6:** Clearly there must be a display function to use the mobile phone's LCD (paragraph 0002) to display game information such as collective use information, amongst other information.

**Claim 7:** Emmerson discloses a series of games being downloaded to the mobile phone (paragraph 0041, where Emmerson discloses upon a player submitting a new game outcome or result, the game server could send out the next fixture or level in the competition, where the competition has multiple games, fixtures, levels, or the like, thereby being a series of downloaded games).

**Claim 11:** Emmerson discloses the personal portable device is a mobile or cellular telephone, as discussed above, which may be interpreted as a personal data assistant as a mobile phone assists in personal data (i.e. address book). Emmerson discloses the personal data assistant is connected to operator server (figure 2[server 42]), which relays communication to the game server (figure 2[server 31]) connected to the operator server.

**Claim 18:** Emmerson discloses the at least one game is operable in a tournament for fame mode where the game server computer receives and processes game result from a group of personal portable devices (paragraph 0008).

**Claim 17:** As previously discussed throughout this action, Emmerson discloses a registration or subscription feature to allow a player to register to play on a game server for participation in game tournaments operated on the game server (i.e. competitions as disclosed by Emmerson), where games are played on the personal portable devices and game results are communicated to the game server computer when connected thereto.

**Claim 19:** See the rejection of claim 3.

**Claims 20 & 21:** Emmerson as modified and discussed above with respect to claim 1 teaches that a player would have access to both high scores list in the local mode or in the registered mode, such that it would be an obvious matter that the 'game' in local mode allows access to high scores



for registered mode (i.e. even if the player is not registered, downloading of a known global high scores list is an obvious design consideration).

Claims 2, 8-10, 12, & 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emmerson, as applied to claims 1, 3-7, 11, & 17-21, where applicable, further in view of Acres (U.S. Patent Application Publication No. 2001/0034643).

**Claims 2, 8, 9, 12, 14, & 16:** Emmerson discloses the invention substantially as claimed except for explicitly disclosing a sweepstakes mode, the sweepstakes mode being based on various gaming activities such as an entry for each time at least one game is played and communicated to a game server during a predetermined time period, an entry for registration and the number of times the eligible games are played and communicated to the game server, or an entry each time a game in the sweepstakes mode is simply played. Regardless of such a deficiency in Emmerson, those of ordinary skill in the art would have found such a sweepstakes mode to be a notoriously well known option in the gaming arts for implementation in a variety of gaming applications. Specifically, the Examiner submits that Acres explicitly teaches a sweepstakes mode of gaming in which an advertisement system may provide an incentive for a user to play a game and view advertisements by offering rewards such as entries to sweepstakes based on a variety of gaming activities, such as a user who completes a game within a certain period of time, a user who has one of the 10 highest scores, or a user who has one of the longest winning streaks may receive this additional reward (paragraph 0018). While Acres is directed to casino gaming using gaming terminals (i.e. slot machines or the like), the teachings of Acres appear applicable in a variety of different gaming applications (i.e. mobile gaming, computer gaming, console gaming, etc.). Given Acres teachings, one skilled in the art would have found it obvious to implement a sweepstakes mode in the mobile

games played within the Emmerson invention to benefit both the players (i.e. providing additional ways to win – a sweepstakes drawing) and the gaming hosts (i.e. additional revenue from advertising sponsors). The concept of advertising and providing additional awards, such as sweepstakes entries or raffle tickets, has been notoriously well known in the art for some time, and upon Applicant's request the Examiner will submit numerous additional prior art literature that discusses these types of marketing techniques to attract more players and generate higher revenues for gaming hosts. Acres, as seen in figure 1, has four portions of the game screen dedicated to advertisements, and as is known in the marketing industry, advertisements are not cheap, thus clearly the gaming hosts are generating a plentiful revenue stream from these advertisements. Consequently, the gaming hosts are able to offer a wide variety of additional bonuses or rewards to players for their loyalty and game play. Therefore, for at least the reasons provided, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Emmerson to implement a sweepstakes "mode" of the mobile games applications. Further, it would have been obvious to base the individual entries off a plethora of possible measurable gaming activities including those discussed above, for at least the reason that if Acres provides sweepstakes entries for such activities as obtaining a high score, it would be art recognized equivalents to base sweepstakes off additional obvious variants - basically, it appears any gaming activities that could be monitored or measured in some way could be used by a game designer to implement the known sweepstakes mode based on said gaming activities. Regarding claim 16, as previously explained, Emmerson discloses downloading a plurality of games, where in view of Acres, at least some of the games having options to allow play of said games in a sweepstakes mode.

**Claim 10:** The combination of Emmerson & Acres teaches a advertisements server (Acres, abstract), thus, when implementing the teachings of Acres into Emmerson, it would have been obvious to display advertisements obtained from the advertisement server when the device is in communication with the game server computer (i.e. where the advertisement server may be implemented as part of the game server, or alternatively where it has been held in court that a mere combination of elements of the prior art is not a reasons for patentability – in this case, combining the advertisements server and the game server of the prior art to form a single server performing both tasks).

**Claim 15:** Emmerson discloses mobile gaming, where the mobile gaming is carried out on a wireless telephone device, such as a mobile or cellular phone, said phone is in wireless communication to access and communicate with a game server (figure 2 & paragraph 0002).

### ***Response to Arguments***

The Examiner thereby withdraws any outstanding rejections over Nokia as presented in the previous rejection, in view of Emmerson as applied to all pending claims.

Applicant's arguments filed November 1, 2008, with respect to the Emmerson reference, have been fully considered but they are not persuasive. The Examiner updates the rejections above, thus, a full respond to the arguments are incorporated in the updated rejections above. In summary, the Examiner is not persuaded that a local mode and registered mode as claimed patentably distinguishes from Emmerson as made obvious in view of known teachings in the art as applied above and previously applied to dependent claim 13. See the rejection for a detailed response.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MBS/

/Scott E. Jones/  
Primary Examiner, Art Unit 3714